

Applicants disagree that the invention of the present application is fully disclosed in the referenced copending application and would be covered by any patent granted thereon. The two do not claim common subject matter. The side by side listing of the claims in the action does not support the conclusion that the two applications claim common subject matter.

Independent claim 1 herein specifies:

A method of providing electrical system monitoring and diagnosis, comprising: providing a motor controller including solid state switches for controlling application of power to the motor, and a control circuit for controlling operation of the solid state switches and for measuring electrical power system characteristics relating to operation of the solid state switches; providing an external monitoring and diagnostic device; establishing communications between the control circuit and the external monitoring and diagnostic device, and periodically transferring parameters of the measured electrical power system characteristics from the control circuit to the external monitoring and diagnostic device to monitor electrical power system characteristics in real time.

Claim 1 of the copending '320 application specifies:

A method of configuring a motor controller with an external device, comprising: providing the motor controller to include solid state switches for controlling application of power to the motor, and a control circuit for controlling operation of the solid state switches, the control circuit comprising a programmed processor for commanding operation of the solid state switches, and a memory connected to the programmed processor for storing parameters relating to operation of the solid state switches; providing an external device to include a memory for storing parameters relating to operation of the solid state switches, establishing communications between the programmed processor and the external device, and transferring a configuration database file between the controller memory and the external device memory, the configuration database file comprising a plurality of the stored parameters relating to operation of the solid state switches.

The action indicates that the claims differ in that those of the present application have the phrase "an external monitoring and diagnostic device" and the copending '320 application a "database file". Applicants disagree. In fact, claim 1 of this application is directed to a method of providing electrical system monitoring and diagnosis. Claim 1 of the '320 application is directed to

a method of configuring a motor controller with an external device. Monitoring and diagnosing an electrical system is distinct and unrelated to configuring a motor controller with an external device.

Claim 1 herein specifies providing a motor controller which measures electrical power system characteristics relating to operation of solid state switches. Claim 1 of the '320 application specifies providing a motor controller including a control circuit comprising a programmed processor for commanding operation of solid state switches and a memory connected to the program processor for storing parameters relating to operation of the solid state switches. Measuring electrical power system characteristics is unrelated to storing parameters relating to operation of the solid state switches.

Claim 1 herein specifies providing an external monitoring and diagnostic device. Claim 1 of the pending '320 application specifies providing an external device to include a memory for storing parameters relating to operation of solid state switches. The monitoring and diagnostic device is not the same as a device storing parameters relating to operation of solid state switches.

Finally, claim 1 herein specifies periodically transferring parameters of the measured electrical power system characteristics from the control circuit to the external monitoring and diagnostic device to monitor electrical power system characteristics in real time. Claim 1 of the '320 application specifies transferring a configuration database file between a controller memory and the external device memory, the configuration database file comprising a plurality of the stored parameters relating to operation of the solid state switches. Again, transferring parameters of measured electrical power system characteristics for monitoring in real time is distinct and unrelated

to transferring a configuration database file. It is apparent due to the outlined differences that the claims are patentably distinct from each other.

The action characterizes the claims herein as broader than the claims in the copending '320 application. There is no basis set forth in the action for such a statement. It is not readily apparent which claims might be characterized as broader. The claims are different and directed to different subject matter.

If the claims were not patentably distinct from each other, then they could be included in the same application. However, MPEP §806.04 specifies that combinations having different modes of operation or different functions or different effects are independent. A process of painting a house and a process of boring a well are set forth as an example. If the two different combinations are independent, then restriction is proper and they should be set forth in separate applications. Under such circumstances, a double patenting rejection is improper.

Applicants submit that a method of providing electrical system monitoring and diagnosis is an independent invention relative to a method of configuring a motor controller with an external device. The two methods have different modes of operation, different functions and different effects. Being independent, the two inventions are patentably distinct and the double patenting rejection is improper.

Independent claim 11 of the present application is directed to a motor controller system for monitoring and diagnosing electrical power system characteristics. Claim 11 of the copending '320 application specifies an externally configurable motor controller system. While these

claims are directed to apparatus, the differences between these claims are generally similar to the differences noted above relative to claim 1 of the respective applications. Similarly, claim 21 of the present application specifies a soft starter system from monitoring and diagnosing electrical power system characteristics. Claim 21 of the copending '320 application specifies an externally configurable soft starter system. These claims are also independent and are patentably distinct from one another.

It is not apparent from the action why it would be obvious to modify a method or system for configuring a motor controller to include methods and systems for monitoring and diagnosis of electrical power system characteristics.

As the Court of Appeals, Federal Circuit, held in In re Wright, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988):

"The problem solved by the invention is always relevant. The entirety of a claimed invention, including the combination viewed as a whole, the elements thereof, and the properties and purpose of the invention, must be considered.

Factors including unexpected results, new features, solutions of a different problem, novel properties, are all considerations in the determination of obviousness in terms of 35 U.S.C. §103. When such factors are described in the specification they are weighed in determining, in the first instance, whether the prior art presents a prima facie case of obviousness."

The problem solved by the present invention, namely, monitoring and diagnosis of electrical power system characteristics, is distinct and unrelated to the problem addressed in the


compending '320 application which relates to configuring a motor controller with an external device. The two inventions solve different problems in different ways. As such, the claims herein are not obvious over the claims of the compending '320 application so that the rejection is improper for this reason as well.

For the reasons discussed above, the rejection of independent claims 1, 11 and 21, and the related dependent claims, is improper and ought be withdrawn.

Reconsideration of the application and allowance and passage to issue are requested.

Respectfully submitted,

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